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09/415,205	10/12/1999	CHIAKI IGARASHI	Q56197	4491

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SUGHRUE MION ZINN MACPEAK & SEAS  
2100 PENNSYLVANIA AVENUE N W  
WASHINGTON, DC 20037

EXAMINER

GARY, ERIKA A

ART UNIT	PAPER NUMBER
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2681

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DATE MAILED: 04/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/415,205

Applicant(s)

IGARASHI, CHIAKI

Examiner

Erika A. Gary

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on January 9, 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Allowable Subject Matter***

1. The indicated allowability of claims 3 and 5 is withdrawn in view of the newly discovered reference(s) to Peck, US Patent Number, 6,606,491. Rejections based on the newly cited reference(s) follow. Therefore, this action is non-final.

### ***Claim Objections***

2. Claim 12 is objected to because of the following informalities: "preliminarily" should be deleted on line 9. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 6, 10 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Ghafoor, US Patent Number 6,618,587 (hereinafter Ghafoor).

Regarding claim 1, Ghafoor discloses a radio telephone system, in which a plurality of slave telephone sets (handset) is connected to a public telephone network

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through radio communication with a master telephone set (switching system), wherein: a plurality of unit IDs (directory numbers) are registered in each of the slave telephone sets each unit ID identifying its slave telephone set, and the plurality of unit IDs are also registered in the master telephone set [col. 2: lines 8-11; col. 4: lines 18-30; col. 5: lines 23-40].

Regarding claims 6, 10, and 12, Ghafoor discloses a radio telephone system, in which a plurality of slave telephone sets is connected to a public telephone network through radio communication with a master telephone set, the system comprising: a plurality of slave telephone sets, each slave telephone set with a plurality of unit IDs registered, each unit ID identifies its slave telephone set; a master telephone set with the plurality of unit IDs also registered in the master telephone set; means for transmitting a line connection request signal and selected unit ID among the registered unit IDs on a control channel to the master telephone set, in response to a first telephone set connected to the slave telephone set being hooked off to make a telephone call; means for checking by the master telephone set whether the received unit ID is of the master telephone set's slave telephone, in response to receipt of the line connection request and the unit ID; means for finding a vacant communication channel and assigning this vacant communication channel to the slave telephone set, if the unit ID is of the master telephone's slave telephone; means for checking whether the assigned communication channel is vacant and, if it is vacant, transmitting a confirmation signal by the slave telephone set, in response to the assignment of the communication channel; and means for executing operation of line connection to the

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public telephone network by the master telephone set, in response to receipt of the confirmation signal from the slave unit [col. 1: line 61 – col. 2: line 23; col. 4: lines 18-30; col. 5: line 24 – col. 6: line 2].

5. Claims 1-5, and 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Peck, US Patent Number 6,606,491 (hereinafter Peck).

Regarding claim 1, Peck discloses a radio telephone system, in which a plurality of slave telephone sets (mobile terminal) is connected to a public telephone network through radio communication with a master telephone set (base station or cell site), wherein: a plurality of unit IDs (ESN, MIN) are registered in each of the slave telephone sets each unit ID identifying its slave telephone set, and the plurality of unit IDs are also registered in the master telephone set [col. 1: lines 46-54; col. 5: lines 24-26].

Regarding claim 2, Peck discloses a radio telephone system, in which a plurality of slave telephone sets (mobile terminal) is connected to a public telephone network through radio communication with a master telephone set (base station or cell site), wherein: a plurality of unit IDs (ESN, MIN) are registered in each of the slave telephone sets each unit ID identifying its slave telephone set, and the plurality of unit IDs are also registered in the master telephone set [col. 1: lines 46-54; col. 5: lines 24-26]; and whenever each slave telephone set makes radio communication with the master telephone set, a unit ID corresponding to the radio communication is selected thereby allowing for simultaneous assignment of at least two communication channels for a single slave telephone set [col. 6: line 56 – col. 7: line 8].

Regarding claim 13, Peck discloses a radio telephone system, in which a plurality of slave telephone sets (mobile terminal) is connected to a public telephone network through radio communication with a master telephone set (base station or cell site), wherein: a plurality of unit IDs (ESN, MIN) are registered in each of the slave telephone sets [col. 1: lines 46-54; col. 5: lines 24-26], and the plurality of unit IDs are also registered in a plurality of master telephone sets [col. 4: lines 53-56; col. 5: lines 24-31 (dual-mode terminals register unit IDs, i.e. ESN/MIN, in first and second networks)].

Regarding claim 15, Peck discloses a radio telephone system, in which a plurality of slave telephone sets (mobile terminal) is connected to a public telephone network through radio communication with a master telephone set (base station or cell site), wherein: a plurality of unit IDs (ESN, MIN) are preliminarily registered in each of the slave telephone sets each unit ID identifying its slave telephone set, and the plurality of unit IDs are also registered in the master telephone set, and whenever each slave telephone set makes radio communication with the master telephone set, a unit ID corresponding to the radio communication is selected [col. 1: lines 46-54; col. 5: lines 24-26], and the plurality of unit IDs registered in each slave telephone set is registered in a plurality of master telephone sets [col. 4: lines 53-56; col. 5: lines 24-31 (dual-mode terminals register unit IDs, i.e. ESN/MIN, in first and second networks)].

Regarding claim 3, Peck discloses the plurality of unit IDs registered in each slave telephone set is registered in a plurality of master telephone sets [col. 4: lines 53-56; col. 5: lines 24-31 (dual-mode terminals register unit IDs, i.e. ESN/MIN, in first and second networks)].

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Regarding claims 4, 14, and 16, Peck discloses each slave telephone set is capable of utilizing both analog and digital radio communication [col. 4: lines 11-14, 53-56].

Regarding claim 5, Peck discloses the plurality of unit IDs registered in each slave telephone set is registered in a plurality of master telephone sets [col. 4: lines 53-56; col. 5: lines 24-31 (dual-mode terminals register unit IDs, i.e. ESN/MIN, in first and second networks)] and each slave telephone set is capable of utilizing both analog and digital radio communication [col. 4: lines 11-14, 53-56].

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over prior art cited in the previous Office Action, Hachimura, US Patent Number 6,327,477 (hereinafter Hachimura), in view of Bannister et al., US Patent Number 6,097,968 (hereinafter Bannister).

Regarding independent claims 6, 10, and 12, Hachimura discloses a master and a plurality of slave units in which the master communicates with the plurality of slave units and contains a memory which stores terminating/transmitting processor, a call-end processor, and a call processor and an operational controller for supervising wireless

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connection and disconnection between the master and slave. Hachimura teaches both management of wireline and wireless link disconnect [col. 3: line 55 – col. 4: line 4].

Hachimura further discloses detecting an on hook and off hook condition of a telephone set connected to the slave unit, wherein a line connection request signal is sent and confirmed to the master unit [col. 4: lines 14-57].

What Hachimura does not specifically disclose is that the unit IDs are preliminarily registered in the slave and master units, wherein IDs are matched for confirmation of assignment of vacant communication channels to the slave unit. However, Bannister teaches this limitation [col. 4: lines 10-14, 52-55; col. 5: lines 5-22; col. 6: lines 15-28].

Hachimura and Bannister are combinable because they are from the same field of endeavor, that is, communications systems with master and slave stations. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify Hachimura to include Bannister. The motivation for this modification would have been to specifically point out that the call processing in the master unit of Hachimura would have included preliminary registration of the slave units which comprises storing a plurality of unit identifications for the purpose of allowing detection, notification, and confirmation of communicable slave units for the processing of incoming calls as taught by Hachimura [col. 4: lines 14-57].

Regarding claim 7, Hachimura and Bannister disclose the limitations of claim 6. Hachimura is further evidence of the radio telephone system wherein when a second telephone set is hooked off to make a telephone call while the first telephone is in



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communication, a line connection request and the unit ID are transmitted on the control channel and the line connection for the first telephone set is executed [col. 4: lines 14-57].

Regarding claim 8, Hachimura and Bannister disclose the limitations of claim 6. Hachimura is further evidence of the radio telephone system wherein when a second telephone is hooked off to discontinue its communication in the state that both the first and second telephone sets are in communication, a communication off request is transmitted from the second telephone set to the master telephone set; and in response to receipt of the communication off signal, the master telephone set transmits a communication off signal to the second telephone set, thus ending the communication and restore the second telephone set to the standby state [fig. 3].

Regarding claim 9, Hachimura and Bannister disclose the limitations of claim 6. Hachimura is further evidence of the radio telephone system wherein when the first telephone set is hooked on, a communication off request is transmitted from the first telephone set to the master telephone set; and in response to receipt of the communication off request, the master telephone set transmits a communication off signal to the first telephone set thus ending the communication and restores the telephone set to the standby state [fig. 3: steps 308-315].

Regarding claim 11, the combination of Hachimura and Bannister disclose the limitations of claim 10. Hachimura further discloses wherein the master telephone set sends out via the communication channel an instruction to ring the bell to the slave telephone set [col. 4: lines 66-67].

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### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1, 2, 12, 13, and 15 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed January 9, 2004 with respect to claims 6 and 10 have been fully considered but they are not persuasive. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Further, Bannister teaches multiple unit IDs (MINs) stored in a single slave telephone set (RU) [col. 4: lines 10-14, 52-55; col. 5: lines 5-22; col. 6: lines 15-28].

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shimanuki, JP Patent Number 05102921 discloses a plurality of slave unit IDs being registered in a plurality of master stations.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erika A. Gary whose telephone number is 703-308-0123. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, supervisor Marsha Banks-Harold can be reached on 703-305-4379. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750 or to the 2600 Customer Service Office at 703-306-0377.

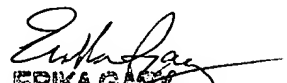
**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 872-9306 (for informal or draft communications, please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive Arlington, VA., Sixth Floor (Receptionist).

  
ERIKA GARY  
PATENT EXAMINER

EAG  
April 4, 2004